

REMARKS

In the Office Action mailed November 1, 2007, the Examiner rejected claims 31-36 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 7-11, 17-21, and 27-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,018,718 to Walker et al. (hereinafter, "*Walker*"); and rejected claims 5-6, 15-16, and 25-26 under 35 U.S.C. § 103(a) as being obvious over *Walker*. Claims 31-36 were not rejected under either of 35 U.S.C. §§ 102 or 103.

By this response, Applicants hereby amend claims 10, 20, and 30 to correct for antecedent basis issues. In addition, Applicants cancel claims 35 and 36 without prejudice or disclaimer of their subject matter. Accordingly, claims 1, 5-11, 15-21, 25-34 are currently pending.

Based on the foregoing amendments and the reasoning presented below, Applicants respectfully traverse the rejection of claims under 35 U.S.C. §§ 102(b), 103(a), and 112, ¶ 1, and request allowance of pending claims 1, 5-11, 15-21, and 25-34.

I. Amendment to the Specification

By this response, Applicants hereby amend the specification at paragraph [034] to correct for typographical errors. No new matter has been added by this amendment. Accordingly, Applicants hereby request entry of the amendment to the specification.

II. Rejection Under 35 U.S.C. § 112, First Paragraph

Applicants respectfully disagree with the Examiner's characterization of claims 35 and 36. However, to advance prosecution, Applicants hereby cancel claims 35 and 36, thereby rendering the rejection of those claims under 35 U.S.C. § 112, ¶ 1 moot.

Applicants respectfully traverse the rejection of claims 31-36 under 35 U.S.C. § 112, ¶ 1, for allegedly “failing to comply with the written description requirement.” Office Action, p. 2. The Examiner states that, “[t]he claim(s) contain[] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *Id.*

Applicants respectfully disagree with the Examiner's characterization of the claims as lacking written description in the specification. *M.P.E.P.* § 608.01(o) states, “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import.” Further, “[t]here is no requirement that the words in the claim must match those used in the specification disclosure.” *M.P.E.P.* § 2173.05(d).

Applicants respectfully direct the Examiners attention to the specification at, for example, paragraphs [032] - [041]. These paragraphs, in conjunction with the figures and pending claims, provide significant written description of the subject matter of claims 1-34.

Moreover, while of different scope than independent claim 1, the recitations of claim 31, cited by the Examiner, can also be found in claim 1. For example, the Office Action states that “[t]he examiner is unable to find in the applicants specification any disclosure to support . . . ‘providing the second amount of reward points to the financial account.’” Office Action, p. 3. This recitation is similar to, but different in scope from, claim 1's recitation of “providing the determined amount of reward points to the financial account.” Similarly, the Office Action states that “[t]he examiner is unable to find in the

applicants specification any disclosure to support . . . 'modifying a third amount of reward points based upon the second amount of reward points, to generate a fourth amount of reward points.'" *Id.* Again, this recitation is similar to, but different in scope from, claim 1's recitation of "adding the provided amount of reward points to a reward point balance to generate an updated reward point balance." The Examiner apparently found sufficient written description for each of these claim 1 recitations in the specification and, accordingly, should similarly find sufficient written description for these claim 31 recitations.

Finally, the Office Action states that "[t]he examiner is unable to find in the applicants specification any disclosure to support . . . 'providing the fourth amount of reward points to the financial account.'" Office Action, p. 3. Applicants respectfully direct the Examiner's attention to, for example, paragraphs [040]-[042] of Applicants' Specification for support of this recitation.

Thus, while the descriptive portion of the specification may not use the exact terms "first amount of reward points," "second amount of reward points," "third amount of reward points," and "fourth amount of reward points," as stated in the *M.P.E.P.*, there is no requirement that the words in the claim must match those used in the specification. Therefore, Applicants respectfully submit that the specification provides sufficient written description for the recitations of claims 31-34, and the meaning of the terms is readily apparent from the descriptive portion of the specification.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 31-36 under 35 U.S.C. § 112, ¶ 1.

III. Rejection of Claims 31-36 Under 35 U.S.C. § 102 and 103

Applicants respectfully note that a complete examination of the claims was not made in this Office Action. Specifically, the Examiner only set forth rejections of claims 31-36 under 35 U.S.C. § 112, ¶ 1, neglecting to address any other statutory provision.

“Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are to be found deficient with respect to some statutory requirement.” *M.P.E.P.* § 2106(II) (emphasis added). Once USPTO personnel have concluded the [] analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all the proposed rejections and their basis to confirm that they are able to set forth a *prima facie* case of unpatentability. *M.P.E.P.* § 2106(VII) (emphasis added). “Only then should any rejection be imposed in an Office action.” *Id.* (emphasis added).

Here, the Examiner only rejected claims 31-36 citing 35 U.S.C. § 112, and failed to indicate examination of these claims and application of prior art under §§ 102 and 103. Therefore, if the Examiner neglected to examine the claims for compliance with 35 U.S.C. §§ 102 and 103, this is improper. Conversely, if the Examiner did in fact examine the claims for compliance under the aforementioned sections, the Examiner then failed to indicate the presence of allowable subject matter, and this too is improper. Accordingly, this renders the Office Action legally deficient, and the Office Action should be withdrawn.

IV. Claim Rejection Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1, 7-11, 17-21, and 27-30 under 35 U.S.C. § 102(b) as being anticipated by *Walker*. A proper anticipation rejection requires that “each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” *M.P.E.P.* § 2131. In addition, “[t]he elements must be arranged as required by the claim” *Id.* (emphasis added) Applicants respectfully submit that *Walker* fails to disclose all of the subject matter recited in each of the independent claims, and also fails to disclose the elements as arranged by the claims.

Walker fails to disclose “determining an amount of reward points to provide to the financial account based on the reward incentive parameter and the received payment amount, wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a due date” and “adding the provided amount of reward points to a reward point balance,” as recited in independent claim 1.

Instead, *Walker* discloses a “method . . . for providing and managing a customized reward offer to a holder of a financial account . . . includ[ing] the step[s] of determining a first performance target associated with the financial account . . . selecting a reward offer having an associated reward description and transmitting the first performance target and the reward description to the account holder.” *Walker*, col. 3, ll. 16-25. *Walker* further teaches a “performance target and corresponding reward offered to a particular card holder account.” *Id.* at col. 5, ll. 63-64. *Walker* states “[t]he

type of performance target applicable to a card holder account is generally selected from a set of target types defined by the credit card issuer,” and discloses examples of performance targets, such as, target quarterly charge volume, target quarterly outstanding balance, target number of transactions per month, target monthly principle payments, target annual purchases at specific merchants, and target balance transfer amounts. *Id.* at col. 6, ll. 19-29. *Walker* further discloses a “reward terms element . . . to provide rewards to a credit card account in the event the performance target has been achieved.” *Id.* at col. 6, ll. 48-52.

While the Office Action asserts that “*Walker* discloses . . . wherein determining the amount of reward points includes reducing an amount of reward points based on a determination that at least one of the received payment amount or the received payment was received after a payment due date,” this is incorrect. Office Action, p. 4. Rather, *Walker* teaches that “[i]f the card holder performance value is less than or equal to the 90% of the first 416, CCI 200 determines the second target parameter . . . and sets the second reward terms equal to the first reward terms” *Id.* at col. 11, ll. 6-10. *Walker* states, “[t]his is intended to **reduce the target** to enable to cardholder to achieve it.” *Id.* at col. 11, ll. 11-12 (emphasis added).

Moreover, the Office Action states that “[i]f the customer does not meet the performance value [e.g., a payment amount], a check is made to see if the performance was greater or less than 90% of the target.” Office Action, p. 15. “If it is less than 90% the target parameter is reduced and the second reward terms are set equal to the first reward terms.” *Id.* However, this appears to be a misstatement of the teachings of *Walker*.

That is, referring to Figure 6, *Walker* clearly states that “[i]f the card holder has failed to achieve the performance targets determined at step 612, no rewards are awarded, as shown by step 628.” *Walker*, col. 10, ll. 7-9 (emphasis added). Referring to Figure 7, *Walker* states “[i]f the card hold performance had failed to meet the performance target, the card holder would not be eligible for a reward, as shown at step 712.” *Id.* at col. 10, ll. 28-30 (emphasis added).

Thus, *Walker* does not teach “determining an amount of reward points to provide to the financial account based on the reward incentive parameter and the received payment amount, wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a due date” and “adding the provided amount of reward points to a reward point balance,” as recited in Applicants’ independent claim 1. Rather, *Walker* teaches that a reward is not awarded.

For at least the above-outlined reasons, *Walker* fails to disclose all of the subject matter recited in Applicants’ independent claim 1. Therefore, the rejection of independent claim 1 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Independent claims 11 and 21 although of differing scope, recite elements similar to that of independent claim 1, and are therefore allowable for at least the same reasons. Therefore, the rejection of independent claims 11 and 21 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claims allowed.

Claims 7-10 depend from independent claim 1. Claims 17-20 depend from independent claim 11. Claims 27-30 depend from independent claim 21. As discussed above, *Walker* does not support a rejection of independent claims 1, 11, and 21. Therefore, dependent claims 7-10, 17-20, and 27-30 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claims.

V. Claim Rejection Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 5, 6, 15, 16, 25, 26 under 35 U.S.C. § 103(a) as unpatentable over *Walker* because the Examiner has not established a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2141, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P.* § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P.* § 2143.01(III) (internal citations omitted). In addition, when “determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(I) (internal citations omitted) (emphasis in original).

In this application, a *prima facie* case of obviousness has not been established because, among other things, *Walker*, taken alone or in any reasonable variation, does not disclose or suggest each and every feature of Applicant's independent claims. Specifically, *Walker* fails to disclose or suggest, *inter alia*, "determining an amount of reward points to provide to the financial account based on the reward incentive parameter and the received payment amount, wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a due date" and "adding the provided amount of reward points to a reward point balance," as recited in independent claim 1.

Claims 5, 6, depend from independent claim 1. Claims 15 and 16 depend from independent claim 11. Claims 25 and 26 depend from independent claim 21. As explained, *Walker* does not teach "determining an amount of reward points to provide to the financial account based on the reward incentive parameter and the received payment amount, wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a due date" and "adding the provided amount of reward points to a reward point balance," as recited in Applicants' independent claim 1 and similar recited in claims 11 and 21.

Indeed, while the Office Action asserts that "Walker discloses ... wherein determining an amount of reward points includes reducing the amount of reward points

based on a determination that the customer came close to achieving their designated performance value," (Office Action, p. 3), as discussed above, *Walker* clearly teaches that **a reward is not awarded**.

Thus, neither *Walker*, nor any obvious variant thereof, teaches or suggests all the elements of independent claims 1, 11, and 21, from which claims 5-6, 15-16, and 25-26 respectively depend. Therefore, for at least the same reasons as set forth above in connection with independent claims 1, 11, and 21, the rejection of claims 5-6, 15-16, and 25-26 under 35 U.S.C. § 103(a) is legally deficient, should be withdrawn, and the claims allowed.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

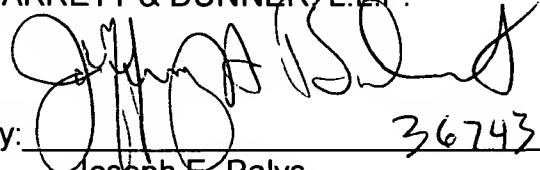
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 1, 2008

By:

A handwritten signature in black ink, appearing to read "Joe Palys", written over a horizontal line.

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